

RESPONSE UNDER 37 C.F.R. § 1.116  
U.S. Appl. No. 10/087,858  
Attorney Docket No. Q68703

**REMARKS**

Claims 1-8 and 11-18 are all the claims pending in the application.

The declaration has been objected to.

In response, Applicants herewith submit a Supplemental Declaration and Power of Attorney, as suggested by the Examiner. Accordingly, the Examiner is respectfully requested to reconsider and withdraw the objection.

At page 2 of the Office Action, the specification has been objected to as allegedly containing new matter.

Applicants respectfully traverse the objection for the following reasons.

The correction for the typographical error of methyl s-butyl ether in Table 1 is supported in the priority document of the present application.

In addition, Applicants respectfully submit that one skilled in the art would know the typographical error (methyl t-butyl ether was listed in both columns 4 and 5 in the Table), and readily ascertain that the one of two “methyl t-butyl ether” is “methyl s-butyl ether”, since no methyl butyl ether but “methyl t-butyl ether” and “methyl s-butyl ether” are produced.

In view of the above, the Examiner is respectfully requested to reconsider and withdraw the objection.

At page 3 of the Office Action, Claims 1-8 and 11-18 have been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable unpatentable over Jackson et al (USP 5,670,702) and Purvis et al (USP 5,981,818) in view of EP 68,785.

Applicants respectfully traverse the rejection for at least the following reasons.

RESPONSE UNDER 37 C.F.R. § 1.116  
U.S. Appln. No. 10/087,858  
Attorney Docket No. Q68703

Applicants respectfully disagree with the Examiner's assertion that the source of methanol has no patentable significance. The source of methanol is one key element that renders the present invention non-obvious over the cited references. That is, a *prima facie* case of obviousness cannot be established in terms of this element.

As stated by the Examiner, it is known that methyl methacrylate may be prepared from methanol and that there is no limitation on the methanol in the production methods of methyl methacrylate disclosed in the cited references.

However, none of the cited references suggests choosing a source of methanol recovered from decomposition of methyl t-butyl ether and using such a methanol for esterifying methacrylic acid and/or methacrolein.

The Examiner considered that one skilled in the art might be motivated to use a source of methanol without disadvantages caused by impurities contained in the methanol. However, this argument is irrelevant, because such utilization of methanol does not directly result in or suggest the present invention, which requires the step of esterifying methacrylic acid and/or methacrolein with methanol. The advantages of the present invention are not always attained and/or expected only by avoiding the disadvantages caused by the impurities contained in the methanol.

Accordingly, the present invention is not obvious over the cited references at least in using the combination of the step of decomposing methyl t-butyl ether and the step of esterifying methacrylic acid and/or methacrolein with a methanol, wherein said methanol is a methanol which is recovered from decomposition of methyl t-butyl ether.

RESPONSE UNDER 37 C.F.R. § 1.116  
U.S. Appln. No. 10/087,858  
Attorney Docket No. Q68703

Further, any possible *prima facie* case of obviousness has been overcome by the superiority of the present invention. Specifically, the present invention provides advantages, such that methanol obtained from decomposition of methyl t-butyl ether is effectively utilized, and that methyl methacrylate having high purities can be obtained with low cost. These advantages cannot be expected in view of the cited references.

Still further, Applicants respectfully traverse the Examiner's statement that "even applicants' source of methanol requires a number of purification steps as shown by the instant examples" (page 3 of the Office Action, lines 4-6 from the bottom). The Examples disclosed in Applicants' specification should not be construed as any limitation upon the scope of the present invention.

In view of the above, Applicants respectfully submit that the present invention is not obvious over the cited references, and withdrawal of the rejection is respectfully requested.

Reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

RESPONSE UNDER 37 C.F.R. § 1.116  
U.S. Appln. No. 10/087,858  
Attorney Docket No. Q68703

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



---

Fang Liu  
Registration No. 51,283

SUGHRUE MION, PLLC  
Telephone: (202) 293-7060  
Facsimile: (202) 293-7860

WASHINGTON OFFICE  
**23373**  
CUSTOMER NUMBER

Date: January 30, 2004